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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/792,142

03/03/2004

George H. Forman

10007903-2

4833

7590

11/16/2004

HEWLETT-PACKARD COMPANY

Intellectual Property Administration

P. O. Box 272400

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EXAMINER

STEWART JR, CHARLES W

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

my

Office Action Summary	Application No. 10/792,142	Applicant(s) FORMAN, GEORGE H.	
	Examiner Charles W. Stewart, Jr.	Art Unit 2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/794,704.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Detailed Action

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine ground in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 428, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (May be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of Forman U.S. Patent No. 6,802,586 B2.

Forman discloses a computer consumable component employed with an associated computerized apparatus, comprising:

Art Unit: 2853

In claim 1 with respect to claim 1, the consumable component; incorporated with the consumable component, a memory; and embedded in the memory, readable program code containing at least one downloadable, upgrade version of program code associated with a device selected from a group including, the consumable component, the associated computerized apparatus, and interactional program code associated with both the consumable device and the associated computing apparatus.

In claim 2 with respect to claim 2, the memory further comprising: an electrically readable device.

In claim 3 with respect to claim 3, the memory further comprising: an optically readable device.

In claim 4 with respect to claim 4, the memory further comprising: a magnetically readable device.

In claim 5 with respect to claim 5, the readable program code, further comprising: interactive subroutines for allowing selection of options for installation, operation, or both, of said readable program code.

In claim 6 with respect to claim 6, further comprising: program code for determining if the readable program code is compatible with the associated computerized apparatus and, if not, program code for aborting any a downloading of the readable program code.

In claim 7 with respect to claim 7, the readable program code further comprising: program code for indicating whether the readable program code is a partial listing or a complete listing of an upgrade version thereof.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a readable program code containing at least one

Art Unit: 2853


downloadable, upgrade version of program code associated with a device selected from a group device in order to achieve better print storage while in the print mode.

Contact Information

3. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Charles Stewart, Jr. whose telephone number is (571) 272-2154.

Charles Stewart, Jr.

November 11, 2004


Stephen D. Meler
Primary Examiner